

Application No. 10/603,397

REMARKS

Claims 10-12 are pending. No amendments have been made. Applicant hereby requests further examination and reconsideration of this Application.

Telephone Interview

Applicants respectfully acknowledge and thank the Examiner for the courtesy of the telephone interview conducted with Brad Pedersen on August 11, 2005. During the interview, discussion was held with respect to Japanese Patent No. H6-233772 as directed to the Office Action dated June 14, 2005. A courtesy copy of a translation of this reference had been sent to the Examiner in a letter dated July 27, 2005. A copy of the certified translation is also attached to this response.

35 U.S.C. § 103 Rejection

In the Office Action of June 14, 2005, claims 10-12 that had previously been indicated as allowable were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. H6-233772 to Morita. Applicants respectfully traverse this rejection.

*Prima facie* obviousness is not established if all the elements of the rejected claim are not disclosed or suggested in the cited art. In re Ochiai, 37 USPQ 1127, 1131 (Fed. Cir. 1995). ("The test for obviousness *vel non* is statutory. It requires that one compare the claims' 'subject matter as a whole' with the prior art 'to which said subject matter pertains.'"). See also, MPEP 2143.03, "All Claim Limitations Must Be Taught or Suggested," citing In re Royka, 180 USPQ

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580 (CCPA 1974). "To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art." MPEP 2143.03.

Independent claim 10 is addressed to a *dynamic* bioabsorbable staple that deforms "at a second time *subsequent to the insertion time in response to lateral forces naturally exerted by the opposed sides of the wound.*" Morita teaches a combustible suturing device for use during autopsies of corpses, i.e., within dead tissue. In the tissue of the deceased as described in Morita, there is no tissue healing, and as such, no suggestion, teaching, or disclosure of deformation of the suturing device in response to lateral forces naturally exerted by the opposed sides of the wound. Furthermore, Morita utterly lacks any disclosure with respect to deformation of the suturing device where the shoulder angle transitions from "a first position at insertion time" to "a second deformed position at a second time subsequent to the insertion time."

Morita shows a first position of the shoulder angle at a time of insertion of approximately 90 degrees; however, there is nothing in Morita that teaches or suggests that the suturing device, once inserted, would be capable of deforming to a second position of the shoulder angle. On the contrary, because the suturing device of Morita is utilized in a corpse, there will necessarily be no "lateral forces naturally exerted by the opposed sides of the wound." Consequently, a *prima facie* case for the obviousness of claim 10 in view of Morita has not been established in the Office Action. Thus, Applicants respectfully request withdrawal of the rejection to independent claim 10, as well as dependent claims 11 and 12.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

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The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

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